

REMARKS

The present application has been reviewed in light of the non-final Office action dated March 4, 2009. Claims 33-42 are pending in the present application.

Claims 1-32 were previously cancelled in a communication to the U.S. Patent and Trademark Office entitled Amendment and Response Under 37 C.F.R. §1.114, dated July 20, 2006. Claims 41 and 42 were previously withdrawn from consideration by the Examiner in an Office action dated October 22, 2007, pursuant to a restriction requirement based on 37 C.F.R. §1.145. Of claims 33-40, claim 33 is in independent form.

By this Amendment, claims 33 and 35 were amended to place the claims in better form for examination. In the claim listing provided herein, the status of claims 41 and 42 now indicate the same as “Withdrawn” to be in compliance with the requirements of 37 C.F.R. §1.121.

Claim Rejections – 35 U.S.C. §112, Second Paragraph

In the Office action, claims 33-40 were rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Specifically, the Examiner alleges that it is not clear what is intended by the term “replaced” recited in claims 33-40.

In response, but without conceding the correctness of the Examiner’s rejections, Applicant notes that claims 33 and 35 have been amended to render the Examiner’s rejections moot. Accordingly, Applicant respectfully requests the withdrawal of the Examiner’s rejections based on 35 U.S.C. §112, second paragraph.

Claim Rejections – 35 U.S.C. §112, First Paragraph

In the Office action, the Examiner rejected claims 33-40 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Specifically, the Examiner alleges that the originally filed disclosure is silent on (i) “identifying the type of the treatment equipment connected to the first connecting portion in response to replacement of the treatment equipment connected to the first connecting portion” and (ii) “control portion outputting identification information corresponding to the type of the treatment equipment identified by the first identification portion when the treatment equipment connected to the first medical device is replaced”.

In response, but without conceding the correctness of the Examiner’s rejections, Applicant respectfully submits that the above-described amendments of claims 33 and 35 render the Examiner’s rejections moot. Accordingly, Applicant respectfully requests withdrawal of the Examiner’s rejections based on 35 U.S.C. §112, first paragraph.

Claim Rejections – 35 U.S.C. §103(a)

In the Office action, the Examiner rejected claims 33-40 under 35 U.S.C. §103(a) as being allegedly unpatentable over Japanese Published Application Publication JP 2001-178734 to Takahashi (hereinafter “734 reference”) in view of U.S. Patent Application Publication No. 2002/0183693 to Peterson et al. (hereinafter “Peterson reference”).

To establish a *prima facie* case of obviousness, the Examiner must demonstrate three requirements with respect to each claim. First, the cited references, when combined, teach or suggest every element of the claim. Second, one of ordinary skill would have been motivated

to combine the teachings of the cited references at the time of the invention. And third, the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.

In light of these requirements, Applicant respectfully submits that the cited references fail to support a *prima facie* case of obviousness for claims 33-40, as presently amended, for at least the following reasons.

Applicant direct the Examiner's attention to the language of amended claim 33 which reads, in pertinent part:

...wherein the first medical device includes a first communication unit capable of transmission and reception with the second medical device, the first medical device transmits identification information, synchronization information, and driving information of the treatment equipment and receives the driving information of the second medical device, and the second medical device receives the identification information, the synchronization information, and the driving information of the treatment equipment from the first medical device and transmits the driving information when the second medical device is to be driven, wherein when the second medical device has already been driven when identification information is received from the first medical device control portion, the second medical device control portion receives no driving information from the first medical device control portion and controls the second medical device to be driven independent of the first medical device, and wherein when the second medical device is not driven when identification information is received from the first medical device control portion, the second medical device control portion receives driving information from the first medical device control portion and establishes synchronized driving with respect to the first medical device or forbids driving of the second medical device.

The language of amended claim 33 provides a surgery system in which the relation of a first medical device and a second medical device is not a constant master-slave relation but is a relation of decentralized control (i.e., parallel relation) in which the master-slave relation is interchangeable.

The '734 reference, as presently understood by Applicant, describes, with references to Figs. 1 and 7, identifying the type of handpiece (probe) connected to the ultrasound output device, determining, based on the identified type of handpiece, whether or not it is necessary to perform synchronized driving control of the ultrasound output device and water-supply/suction device, and transmitting a signal regarding the necessity of the synchronized driving control to the water-supply/suction device. The same also applies to Figs. 4 and 5. In addition, Fig. 11 of the '734 reference illustrates a relation of synchronized driving control between either an electric scalpel device or ultrasound output device and a water-supply/suction device and pneumoperitoneum device. Fig. 11 shows that electric scalpel device 161 and ultrasound output device 162 are connected with a single communication cable, where handpiece 157 is only connected to electric scalpel device 161 but not to ultrasound output device 162, that is a state of using electric scalpel device 161. Paragraph [0123] of the '734 references states: "Fig. 11 illustrates the state of using electric scalpel device handpiece 157m (m=a-d) shown in Fig. 16. In this case, handpiece 157m is connected to electric scalpel device 161 and water-supply/suction device 163, but when using ultrasonic treatment handpiece 157n (n=e-h) shown in Fig. 17, handpiece 157n is connected to ultrasound output device 162." That is, in the '734 reference, electric scalpel device handpiece 157m and ultrasonic treatment handpiece 157n, serving as treatment equipment, are connected to the electric scalpel device and ultrasound output device respective devices, respectively, only when using these devices. It is not that ultrasound output device and electric scalpel device are always connected with treatment equipment for both of these devices. The '734 reference merely describes a relation of synchronized driving control between either electric scalpel device or ultrasound output device which is previously selected and water-supply/suction device and pneumoperitoneum device.

Thus, in the '734 reference, taking electric scalpel device or ultrasound output device as the main device, and water-supply/suction device and pneumoperitoneum device as the supporting device for supporting the main device, conceivably the main device identifies the treatment equipment for use (e.g., handpiece) that is connected to the main device, creates control information on with which of the supporting devices to perform synchronized driving, and based on this control information performs synchronized driving control with one of the supporting devices or prohibits the synchronized driving.

In contrast, the specification of the present application describes: electric scalpel device, ultrasound output device, water-supply/suction device, and pneumoperitoneum device being connected with a communication cable; at least two types of treatment equipments 9, 11, 10 are in constant connection to both of ultrasound output device and electric scalpel device (Fig. 1 of the present application); depending on which treatment equipment is used, only one of ultrasound output device and electric scalpel device is driven, and water-supply/suction device and/or pneumoperitoneum device is synchronizedly or unsynchronizedly driven with the electric scalpel device or ultrasound output device that is driven.

That is in the present invention, of ultrasound output device and electric scalpel device, for example when only ultrasound output device is driven depending on the treatment equipment to be used, control unit of the electric scalpel device receives driving information from the ultrasound output device, thus stopping driving the electric scalpel device. At the same time, control unit of the water-supply/suction device prohibits the water-supply/suction operation based on the driving information from the ultrasound output device. Control unit of the pneumoperitoneum device allows synchronized driving of the pneumoperitoneum device based on the driving information from the ultrasound output device. In this case, ultrasound output

device functions as the master and electric scalpel device functions as the slave with its operation being prohibited under instruction from the ultrasound output device. Furthermore, when only electric scalpel device is driven, the control unit of the ultrasound output device receives driving information from the electric scalpel device, thus stopping driving the ultrasound output device. The control unit of the water-supply/suction device prohibits the water-supply/suction operation based on driving information from the electric scalpel device. The control unit of the pneumoperitoneum device allows synchronized driving of the pneumoperitoneum device based on the driving information from the electric scalpel device. In this case, electric scalpel device functions as the master, and ultrasound output device functions as the slave with its operation prohibited under instruction from the electric scalpel.

Such relation between ultrasound output device and electric scalpel device, in which ultrasound output device functions as the master, is described in the specification of the present application as filed at, for example, page 24, line 1 to page 25, line 9 and page 26, lines 8-14. Moreover, the operation of the control unit of the ultrasound output device is described in the specification at page 18, line 16 and page 19, line 1. That the electric scalpel device functions as a master is described in the specification at, for example, page 26, line 15 to page 27, line 6. The operation of the control unit of the electric scalpel device is described at page 15, lines 14-24.

Therefore, the relation between ultrasound output device as first medical device and electric scalpel device as a second medical device is not a constant master-slave relation but is a relation of decentralized control (parallel relation, i.e., equivalent relation) in which the master-slave relation is interchangeable.

Based on the above, Applicant respectfully submits that the ‘734 reference fails to teach or suggest every element of the claim, and in particular, fails to teach or suggest the above cited portion of amended claim 33.

Peterson, as presently understood by Applicant, describes a master-slave relation in which respective pumps in the patient’s home and caregiver’s office can be used to supply drug to the patient and the pumps can communicate over modems.

Peterson, like the ‘734 reference, also fails to teach or suggest every element of the claim, and in particular, fails to teach or suggest the above cited portion of amended claim 33.

For the reasons above, the cited references fail to teach or suggest every element of amended claim 33. Accordingly, the cited references fail to support a *prima facie* case of obviousness for amended claim 33.

Claim 33 is therefore patentable over the cited references. Claims 34-40, which incorporate all of the limitations of claim 33, are patentable over the cited references based at least upon their dependence to claim 33.

Withdrawal of the Examiner’s rejection of claims 33-40 based on 35 U.S.C. §103(a) is respectfully requested.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

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